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No. 356

In The

Supreme Court of The United States

October Term, 1958

JOSEPH H. SPAULDING, d.b.a. Whiteway Manufacturing Company,

Petitioner,

vs.

GUARDIAN LIGHT COMPANY, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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The petitioner, Joseph H. Spaulding, d.b.a. Whiteway Manufacturing Co., prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the 7th Circuit entered in the above cause on April 28, 1959.

OPINIONS BELOW

The District Court filed no opinion, but entered Findings of Fact and Conclusions of Law reported at 170 Fed. Supp. 679. (Pps. 3 – 17 Appellant's Appendix) The opinion of the Court of Appeals for the Seventh Circuit is reported at 267 F. 2d 111, and is also reprinted herein as Appendix A.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered on April 28, 1959. A timely petition for rehearing was filed before the Court of Appeals and denied June 29, 1959. Jurisdiction of this Court is invoked under 28 U.S.C. Section 1254 (1).

QUESTIONS PRESENTED

(1) Whether the Lower Courts applied the correct criterion of invention.

(2) Whether the record discloses very obvious and exceptional showings of error.

(3) Whether the statutory presumption of validity applies to a duly issued design patent.

(4) Whether the burden of establishing invalidity of a design patent rests upon the party asserting it, as in the case of other patents.

STATUTES INVOLVED

Title 35 U.S.C. Sec. 282:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

RULE 52 — Federal Rules of Civil Procedure

"(a) In all actions tried upon the facts without a jury * * * the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment: * * *. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *

"(b) * * * When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment."

STATEMENT

Petitioner brought an action for infringement of his design patent No. D-168,971 issued March 3, 1953, on a design for a fluorescent lighting fixture.

The District Court held that the claim of the patent was infringed, if valid, but found the patent invalid,

(a) Because of lack of patentable design novelty, originality and design invention;

(b) Because the design shown in the patent is functional and utilitarian and not ornamental;

(c) Because the design of the patent represents merely the expected skill of designers and mechanics working in the art; and

(d) Because of lack of patentable design novelty over the prior art.

The Court of Appeals reversed the holding of invalidity because of lack of patentable design novelty over the prior art and affirmed the other grounds.

The record discloses that petitioner introduced the first commercial, outdoor, horizontal, fluorescent lighting fixture having an "angle" bottom. This fixture, known as the ULRICK angle light, was the subject of design patent No. D-168,812 and was characterized by its elongate, overall V-shape. (P. 82, Appellant's Appendix)

The uncontradicted and unchallenged evidence of record conclusively establishes that although the ULRICK

angle light threw more and better light over a wider area than the various (a) mushroom, (b) pylon, and (c) flat-bottom horizontal lights that preceded it, nevertheless it was a total flop (even though extensively advertised and promoted) *solely* because of its unattractive overall appearance.

The record further establishes that petitioner thereupon applied himself to the task of designing a completely new fixture which combined the superior lighting qualities of the commercially rejected Ulrick angle light with an attractive, eye-appealing, overall appearance. The result of petitioner's efforts culminated in the Spaulding angle light of U. S. design patent No. D 168,974, here in suit (P. 79, Appellant's Appendix)

The uncontradicted and unchallenged evidence of record further and conclusively establishes that the Spaulding angle light met with immediate commercial success — that said immediate success was attributable solely to its overall pleasing attractive appearance — that said commercial success was achieved despite the absence of an advertising or promotional program — that the fixture design established a trend in the field of outdoor lighting fixtures — and that its acceptance by the trade was so great that competition immediately started copying it.

The record is barren of ANY evidence to the contrary.

Respondent relied upon 11 prior art patents for negating the patentable design novelty of the Spaulding patent; of these 11 references, four were cited by the Patent Office and the other seven were merely "cumulative" of the art relied upon by the Patent Office.

It is the position of petitioner that when the Appellate Court reversed the District Court on ground (d) and held that the patent was *not* invalid because of lack of patentable design novelty over the prior art, the Spaulding patent was again and immediately endowed with the statu-

tory presumption of validity conferred upon it by Title 35 U.S.C. Section 282.

The present record is unique in that it includes the Ulrick angle light which was rejected by the trade solely because it did not have any "eye appeal", and the Spaulding angle light which the trade literally demanded because of its "eye appeal"; and the record establishes that the *only* difference between the earlier *rejected* Ulrick angle light and the later *accepted* Spaulding angle light resided in "eye appeal", viz., overall appearances. The cost, illuminating characteristics, functional and utilitarian features of the rejected Ulrick angle light were *identical* with the commercially accepted Spaulding angle light.

The basic issue before this Honorable Court is whether the Lower Courts applied the correct criterion of invention since the record is absolutely devoid of facts to support the conclusions of law reached by the lower courts.

REASON FOR GRANTING THE WRIT

This case presents an important question as to whether the Lower Courts applied the correct criterion of invention as it applies to a design patent, and whether the record provides a "factual" basis to support the legal conclusions reached by the District and Appellate Courts.

Eighty-eight years ago this Court, in *Gorham* v. *White*, 81 U.S. 511, 525 summarized the law as it still applies to design patents as follows:

> "The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.
>
> . . . .
>
> "It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance

> itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense."

The record below uniquivocally establishes that it is and was the "*appearance itself*" of the Spaulding angle light which attracted attention and called out favor; and that it was its "*new and original appearance*" which enhanced its salable value and enlarged the demand for it.

It is petitioner's position that the "findings" of the District Court on which it based its legal conclusion of invalidity are "clearly erroneous".

In the *United States* v. *United States Gypsum Co., et al*, 333 U.S. 364, 394, the term "clearly erroneous" was defined by this Court as follows:

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."

A cursory review of the present record (Pps. 20-74, Appellant's Appendix) proves beyond doubt that there is *no* evidence whatsoever to support the findings of the District and Appellate Courts; and since the findings are clearly erroneous and wholly without support, the conclusions of law based thereon are likewise erroneous and should be set aside.

The "presumption of validity" of a design patent is statutory — and the same statute places the burden of establishing invalidity on the party asserting it; viz., the respondent herein, defendant below.

This Court has repeatedly held that the presumption of validity can be overcome only by clear and convincing evidence to the contrary. *Radio Corp. of America, et al* v.

Radio Engineering Laboratories, Inc., 293 U.S. 1, 7-8; *Mumm v. Jacob E. Decker & Sons*, 301 U.S. 168, 171.

In *Gracer Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 336 U.S. 271, at 275; this Court held:

> "A court of law, such as this court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below IN THE ABSENCE OF VERY OBVIOUS AND EXCEPTIONAL SHOWING OF ERROR." (Emphasis added); Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279; Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U.S. 364.

It is respectfully submitted that even a cursory examination of the record will establish beyond a reasonable doubt a very obvious and exceptional showing of error on the part of the Lower Courts — since the record *negates* rather than supports the factual findings upon which the conclusions of law are predicated.

The Lower Courts finding of invalidity "because the design shown in the patent is functional and utilitarian and not ornamental", completely ignores the record which is replete with uncontradicted testimony which conclusively establishes that the design aspects of the Spaulding angle light were PRIMARILY ornamental and that the functional and utilitarian features of the light were MERELY incidental.

Contrary to the finding of the Lower Courts, the record establishes that the DOMINANT features of the Spaulding angle light which resulted in its immediate and phenomenal commercial acceptance was its new, novel and pleasing overall appearance or "eye appeal".

The conclusion of invalidity "because the design of the patent represents merely the expected skill of designers and

mechanics working in the art" has no factual basis in the record. Respondent offered no evidence from which the Lower Courts could conclude what the expected skill of designers and mechanics working in the art of fluorescent lighting fixtures might be. However, we do have the conclusion of experts in the field, viz., highly trained Patent Office personnel, to the effect that the Spaulding patent represented more than the expected skill of designers and mechanics working in the art. — And we have further the uncontroverted testimony of petitioner's witness to the effect that the Spaulding angle light design was REVOLUTIONARY.

As stated by this Court in *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U.S. 428, at 441:

> "Hence we see the strength of the concession to its advance beyond the prior art and of its novelty and utility by the Rubber Co.'s imitation of it. The prior art was opened to the Rubber Co. * * * and yet the Rubber Co. uses the Grant Tire. It gives the tribute of its praise to the prior art: it gives the Grant Tire the tribute of its imitation as others have done."

The *facts* of the present case present a classical example of the immediate commercial acceptance of an article because of its "eye appeal".

This Court held in *Temco Co. v. Apco Co.*, 275 U.S. 319, at 325:

> "The * * * patent involved invention, by the way in which the public eagerly took it and its marked success. * * *"

The facts of our case show that the Spaulding Angle Light was actually demanded by the trade as soon as it was introduced, and that the demand was directly attributable to its unique overall appearances.

The Appellate Court affirmed the wholly unfounded finding of the District Court that "there was no sufficient showing that any light fixture manufactured by plaintiff, embodying the design of the patent in suit, was commercially successful, as plaintiff had abandoned the manufacture and sale of this fixture as early as the early part of 1955 for the reason of economy in manufacture".

The record positively establishes that Spaulding angle lights *identical* in every respect with and embodying the design of the patent in suit were so enthusiastically received by the trade *from the moment they were commercially available* that orders for them exceeded petitioner's facilities to produce. (P. 24, Appellant's Appendix)

The record further conclusively establishes that the demand for Spaulding angle lights was *immediate* and sustained; said record includes the uncontroverted testimony of a witness (during the time when he was a competitor of petitioner) enumerating sales lost by said competitor to the Spaulding angle light from 1952 to 1955 in the states of Kentucky, Tennessee, Iowa, Montana, Wyoming, Utah, Colorado, New Mexico, Texas, Oklahoma, Louisiana, Alabama, Kansas, Wisconsin and Missouri. (Pps. 59-68, Appellant's Appendix)

The record further discloses that in 1955, over three years *after* the Spaulding angle light was an established commercial success, petitioner made a slight change in the top panel of his light (for reasons of economy) which change neither increased nor decreased the phenomenal demand for the Spaulding angle light; and the record further conclusively establishes that the top panel is never visible when petitioner's fixtures are in use — and that the top panel has no bearing whatsoever on the overall appearances of the fixture.

The findings of the Lower Courts that "every element" of a design is *literally* "essential" is contrary to the ruling

of this Court in *Gorham v. White*, 81 U.S. 511 at 525 wherein it was held that it is the OVERALL APPEARANCES of a device AS SEEN IN USE which governs — and that a design patent is *not* avoided by a device whose OVERALL APPEARANCES are the same but whose *specific details* may differ from the drawings of the patent.

The District Court also found petitioner's design patent invalid "because it is functional and utilitarian rather than ornamental"; and the Appellate Court agreed, holding:

> In the case at bar, this question is a rather close one. However, the plaintiff did advertise in the April 1956 issue of National Petroleum News, page 72, with reference to his commercial fluorescent lighting fixture: 'Patented 15° angle (Pat. No. 168,974) throws MORE light over a WIDER area'. — We think the District Court's finding is not clearly erroneous and agree that the patent in suit is invalid because the design was functional and utilitarian rather than ornamental."

The foregoing legal conclusion of invalidity predicated upon a single advertisement which appeared over four years AFTER the successful introduction of the Spaulding angle light reveals but another VERY OBVIOUS and EXCEPTIONAL SHOWING OF ERROR of which this Court should take cognizance.

It is submitted that the record discloses undisputed facts which conclusively prove that Spaulding design patent D-168,974 embodies patentable subject matter and rises to the dignity of invention and qualifies for and passes all tests of validity as set forth by this Court.

Since respondent has *not* sustained its statutory burden of establishing invalidity of the subject patent, any doubt which the lower courts may have entertained should, under the FACTS OF RECORD, have been resolved in favor of petitioner.

> "* * * the burden of proof rests upon him", the defendant, "and every reasonable doubt should be resolved against him." *Coffin* v. *Ogden*, 18 Wallace 120, 124.
>
> "Commercial success may turn the scale when invention is in doubt." *Smith* v. *Hall*, 301 U.S. 216, 233. *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U.S. 464, 474. *DeForest Radio Co.* v. *General Electric Co.*, 283 U.S. 664, 685.

The *facts* of our case are clearly distinguishable from the *facts* of *Jungersen* v. *Ostby & Barton Company*, 335 U.S. 560, 567, upon which the Appellate Court relied as authority for its statement:

> "Where, as here, however, invention is plainly lacking, commercial success cannot fill the void."

NOTHING in the present record provides a basis for the conclusion of the lower courts that invention is lacking in the subject design patent.

This petition discloses a very obvious and exceptional showing of error on the part of the District and Appellate Courts as to call for an exercise of this Court's power of supervision.

CONCLUSION

It is respectfully submitted that for the reasons above stated, this petition for a writ of certiorari should be granted.

Respectfully,

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APPENDIX A

UNITED STATES COURT OF APPEALS
For the Seventh Circuit

September Term, 1958, April Session, 1959.

No. 12474

JOSEPH H. SPAULDING, dba Whiteway Manufacturing Company,
Plaintiff-Appellant,

vs.

GUARDIAN LIGHT COMPANY, INC.,
Defendant-Appellee.

APPEAL from the United States District Court for the Northern District of Illinois, Eastern Division.

Decided April 28, 1959

Before DUFFY, Chief Judge, and SCHNACKENBERG and KNOCH, Circuit Judges.

DUFFY, Chief Judge: This is a suit for the alleged infringement of Design Patent No. D-168,974 granted to Joseph H. Spaulding on March 3, 1953, on a design for a "Fluorescent Lighting Fixture." The application was filed October 30, 1952. Defendant filed a counterclaim for

a declaratory judgment of invalidity and non-infringement.

The patent in suit discloses a lighting fixture in the form of a housing for fluorescent lighting equipment. The patent contains four drawings. Fig. 1 shows the inclined sides, the bottom and one end of the fixture. Fig. 2 is a bottom plan view. Fig. 3 is a top plan view, and Fig. 4 is an end elevational view.

The District Court held that if the patent were valid, defendant infringed, but further held that the patent was invalid. The basis for such decision was that the patent in suit was invalid a) because of lack of patentable design novelty, originality and design invention; b) because the design shown in the patent is functional and utilitarian and not ornamental; c) because the design of the patent represents merely the expected skill of designers and mechanics working in the art; and, d) because of lack of patentable design novelty over the prior art.

The parties to this suit are competitors in the business of manufacturing and selling lighting equipment for illuminating the pump islands and adjacent areas of gasoline service stations and the exteriors of service station buildings.

Plaintiff claims to have pioneered the so-called angle bottom light which he introduced under Ulrick Patent No. D-168,812. Plaintiff asserts that although this light was vigorously promoted and threw more and better light over a greater area than previous lighting fixtures, it was a commercial flop because of its appearance. During the latter part of 1951, plaintiff claims he worked upon the design of a new fixture which would have "eye appeal."

Three sample light fixtures embodying the new design were made for market testing in December, 1951. One hundred fifty of the Spaulding Angle lights were put up for sale in February, 1952, and plaintiff's witnesses testified they were very well received by the trade. Additional lights with many features of the patented design were sold

but defendant claims that such fixtures were not made in accordance with the teachings of the patent in suit.

The design shown in the patent is of a plain unornamented geometrical configuration and consists of an elongated housing having a pair of end walls, a top walk, a flat longitudinally extending bottom panel and a pair of inclined side bottom panels which extend upwardly from the center bottom panel at an angle of approximately 15 from the horizontal. When these lighting fixtures are installed at filling stations in the usual manner, they rest on tall pipes or standards, usually nine feet above ground level.

The top wall design is shown in Figs. 3 and 4 of the drawings of the patent in suit. The top wall of the fixture is slightly pyramidal in shape. The top wall contains four triangular shaped panels each of which has its apex at the center of the top wall of the housing. Two of these panels extend from the center downwardly and outwardly to the ends of the side walls of the housing. The other two extend downwardly and outwardly to the ends of the end walls of the housing.

There is no description in the specifications or in the claim as to any dominant feature of the design. The claim of the patent in suit is commensurate with the drawings, and it incorporates by reference the design shown in the drawings and reads: "The ornamental design for a fluorescent lighting fixture, as shown." It has been held that where a patent did not point out any particular feature of novelty, every element of the design was essential. *Dixie-Vortex Co.* v. *Lily-Tulip Cup Corp.*, 2 Cir., 95 F. 2d 461.

Title 35 U.S.C.A. § 171 reads: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions

of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided." The present statute omits the term "useful" which was employed in earlier statutes.

A design patent, in order to be valid, must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman: *Hopkins* v. *Waco Products, Inc.*, 7 Cir., 205 F. 2d 221; *Hueter* v. *Compco Corp.*, 7 Cir., 179 F. 2d 416; *Capex Co.* v. *Swartz*, 7 Cir., 166 F. 2d 5. Originality imparts something of uniqueness and character, — something more than mere novelty. 69 CJS. Patents § 73 at page 350. A design patent cannot be obtained to protect a mechanical function or cover an article whose configuration affects its utility alone. 69 CJS. Patents § 73, page 351.

In the case at bar, plaintiff stresses the importance of commercial success. Plaintiff insists that the immediate commercial acceptance of the Spaulding fixture is impressive evidence of patentability. We have held, and it is the general rule, that in a close case commercial success may tip the scales in determining whether an improvement amounts to an invention. *Hueter* v. *Compco Corp.*, *supra*, page 418. However, in the *Hueter* case we pointed out that the Supreme Court in *Jungersen* v. *Ostby & Barton Company*, 335 U.S. 560, 567 said: "Where, as here, however, invention is plainly lacking, commercial success cannot fill the void."

In the case at bar the District Court found that plaintiff failed to show that whatever commercial success his commercial lighting fixture had attained was due to the design disclosed in the patent in suit as distinguished from the utility of the fixture, the sales efforts of plaintiff and other factors. The Court also found there was no sufficient showing that any light fixture manufactured by

plaintiff embodying the design of the patent in suit, was commercially successful, as plaintiff had abandoned the manufacture and sale of this fixture as early as the early part of 1955, for the reason of economy in manufacture. We cannot say that this finding is clearly erroneous.

We do not agree with the District Court that the patent in suit is invalid because lacking patentable novelty, originality and design invention over the prior art. The Court mentioned nine prior art patents, seven of which were not cited by the Patent Office. We think the four prior art patents cited by the Patent Office Tribunals more closely approach the design of the Spaulding Angle Light than any one of the seven additional patents mentioned. To illustrate, Guth Patent No. 2,488,012 and Guth No. 2,401,635 are mechanical patents and are merely cumulative if not identical with Guth No. D-148,695 which was cited by the Patent Office.

The District Court found that plaintiff's design patent in suit was invalid because it is functional and utilitarian rather than ornamental. In *Hopkins* v. *Waco Products, Inc.*, 205 F. 2d 221, 223, we said: "A design dictated by mechanical or functional requirements is not patentable." And, in the *Hueter* case, *supra*, page 417: "The courts have many times held that a purely functional design or one dictated by mechanical or functional requirements is not patentable." In the case at bar, this question is a rather close one. However, the plaintiff did advertise in the April, 1956 issue of National Petroleum News, page 72, with reference to his commercial fluorescent lighting fixture "Patented 15° angle (Pat. No. 168,942)[1] throws MORE light over a WIDER area." This advertisement

[1] It was agreed by the parties that the number of the patent given in the advertisement was in error and that plaintiff intended to refer to No. D-168,974 in suit.

gave the impression that the fifteen degree angle arrangement of the glass side bottom panels was patented. Of course, plaintiff has or had no patent on that feature. We think the District Court's finding is not clearly erroneous and agree that the patent in suit is invalid because the design was functional and utilitarian rather than ornamental.

It would unduly extend this opinion to discuss in detail other points raised by the parties. We are content to state that the record before us supports the trial court's conclusion that the design of the fluorescent lighting fixture in suit represents merely the expected skill of designers and mechanics working in the art and did not represent design invention.

Affirmed

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Appeals for the Seventh Circuit

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vs.

GUARDIAN LIGHT COMPANY, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

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IN THE

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GUARDIAN LIGHT COMPANY, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

INTRODUCTORY STATEMENT.

The action below was an ordinary action for alleged infringement of a design patent, and the petitioner's principal grievance now is that the lower courts held his design patent invalid.

Petitioner and respondent are competitors in the manufacture and sale of fluorescent lighting fixtures including fixtures which are adapted for use in the illumination of the pump island areas of gasoline service stations, and the like.

Petitioner brought the action below in the Northern District of Illinois, Eastern Division, at Chicago, charging

infringement of Design Patent No. D-168,974 granted to him on March 3, 1953 on a Design for a "Fluorescent Lighting Fixture".

The design patent in suit is entirely silent as to any use for which the fluorescent lighting fixture therein shown is intended, but petitioner's commercial fluorescent lighting fixtures and those of respondent are used primarily for the illumination of the pump island areas of gasoline service stations.

However, the District Court found that petitioner's current commercial fluorescent lighting fixtures, which he has manufactured and sold since sometime in the year 1955, do not come under and are not covered by the Spaulding patent No. D-168,974, in suit, because they do not embody the top wall design shown in Figs. 3 and 4 of the drawings of the patent (Finding of Fact No. 13, Applt's. App. p. 6).*

After a full trial on the merits of the case, the District Court held the Spaulding design patent No. D-168,974, in suit invalid and void upon the following grounds:

1. Because of lack of design patentable novelty, originality and design invention (Conclusion of Law No. 2, Applt's. App. p. 16);

2. Because the design shown in the patent is functional and utilitarian and not ornamental (Conclusion of Law No. 3, Applt's. App. p. 16);

3. Because the design shown in the patent represents merely the expected skill of designers and mechanics working in the art of fluorescent lighting fixtures, and did not represent or require design invention (Conclusion of Law No. 4, Applt's. App. pp. 16-17); and

*All references herein to the "Appellant's Appendix" are designated as "Applt's. App." and those to the "Appellee's Appendix" as "Applee's. App."

4. Because the patent in suit lacks design patentable novelty, originality and design invention over the prior art relied upon by the defendant (Conclusion of Law No. 5, Applt's. App. p. 17).

However, the District Court found, alternatively, (Conclusion of Law No. 6, Applt's. App. p. 17), that if the Spaulding design patent No. D-168,974 in suit were valid it was infringed by the defendant's accused fluorescent lighting fixtures

> "* * * for the reason that the composite over-all appearance thereof is substantially similar to the patented device and the differences between them are insufficient to change the effect upon the eye of the ordinary purchaser thereof."

The petitioner (plaintiff below) at no time made any effort to include in the judgment any provision corresponding to the District Court's alternative finding of infringement, as set forth in Conclusion of Law No. 6, above, and hence the defendant did not take a cross-appeal because there was nothing in the judgment of the District Court, as entered, from which the defendant could have taken such a cross-appeal even though the defendant disagreed with the District Court's alternative finding of infringement if the patent were valid.

The petitioner, however, thereupon took an appeal from the judgment of the District Court to the United States Court of Appeals for the Seventh Circuit and that Court, on April 28, 1959, handed down its decision affirming the judgment of the District Court; a copy of the decision of the Court of Appeals being incorporated in the "Appendix" to this brief.

Contrary to the petitioner's contention, the Court of Appeals did not "Reverse" the judgment of the District Court, in any respect, but merely expressed its disagree-

ment with the District Court's Conclusion of Law No. 5 (Applt's. App. p. 17) which found the patent in suit invalid because of lack of design patentable novelty, originality and design invention over the prior art (Second Full Paragraph, page 4, Decision of the Court of Appeals).

In all other respects, however, the Court of Appeals affirmed the Findings of Fact, Conclusions of Law and Judgment of the District Court finding the Spaulding design patent No. D-168,974 in suit, invalid.

SUMMARY OF ARGUMENT.

I.

The judgment of the District Court, as affirmed by the Court of Appeals, finding the Spaulding patent No. D-168,974, in suit, invalid because of lack of design patentable novelty, originality and design invention, and because the design shown in the patent is functional and utilitarian and not ornamental, and because it represents nothing but the expected skill of designers and mechanics working in the art of fluorescent lighting fixtures, and did not represent or require design invention, was based upon a full and exhaustive trial and upon substantial evidence and extensive Findings of Fact and Conclusions of Law, affirmed by the Court of Appeals, and was correct.

II.

The judgment of the District Court, as affirmed by the Court of Appeals, finding the Spaulding design patent No. D-168,974, in suit, invalid because the design shown therein is functional and utilitarian and not ornamental

was based upon substantial evidence and extensive Findings of Fact, and such evidence consisted primarily of the petitioner's own advertising materials and the testimony of petitioner's own witnesses attesting to the fact that the design of the patent was primarily functional and utilitarian and not ornamental, and was correct.

III.

Petitioner's contention that the design of the Spaulding patent No. D-168,974, should be held valid because of alleged commercial success was rejected by the District Court and the Court of Appeals because the petitioner's commercial fluorescent lighting fixtures do not correspond to or embody the design of the patent and petitioner produced no evidence to show that any commercial success which his commercial fluorescent lighting fixtures may have enjoyed was due to anything shown in the patent.

IV.

Petitioner's argument that the District Court and the Court of Appeals failed to apply the correct criterion of invention as applied to a design patent, is without merit.

V.

The Spaulding patent No. D-168,974, in suit, has never been involved in any litigation other than the litigation below, and there is no conflict of decision between the lower courts in the present action and the decision of any other court involving the patent in suit, and there is no unique or important question of law involved, and hence there is no basis for the granting of the petition herein sought.

POINTS AND AUTHORITIES.

I.

The decision of the Court of Appeals for the Seventh Circuit (Appendix) is based entirely upon and relates solely to the particular facts of the action below and presents no unique question of public interest or importance and, under these circumstances, the petition for the Writ herein sought should be denied.

Caroline M. Forsyth v. *City of Hammond, et al.*, 166 U. S. 506, 41 L. Ed. 1095, 1098, 1099.

Rule 19(b) of the Rules of the Supreme Court of the United States, as revised.

Layne and Bowler Corporation v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 67 L. Ed. 712.

II.

There is no conflict of decision between the decision of the Court of Appeals and the decision of any other court as to the facts in issue in the action below and hence no occasion exists for the issuance of the Writ prayed for by the petitioner.

Caroline M. Forsyth v. *City of Hammond, et al.*, 166 U. S. 506, 41 L. Ed. 1095, 1098, 1099.

Rule 19(b) of the Rules of the Supreme Court of the United States, as revised.

III.

The judgment of the District Court finding the Spaulding patent No. D-168,974, in suit, invalid because functional and utilitarian, rather than ornamental, was based upon substantial evidence which the Court of Appeals found not to be erroneous within the meaning of Rule 52(a) of the Federal Rules of Civil Procedure, and was correct.

Graver Tank & Manufacturing Co., Inc. v. *Linde Air Products Co.*, 336 U. S. 271, 275.

Rule 52(a) of the Federal Rules of Civil Procedure.

IV.

Evidence of alleged commercial success, to be of any legal significance, must be shown to have been due to the features shown and claimed in the patent.

Standard Match Corporation v. *Bell Mach. Co.*, 83 F. 2d 365, 367 (C. A. 7) (1936).

ARGUMENT.

I.

The Spaulding Design Patent No. D-168,974, in Suit.

Because of the great emphasis laid by the petitioner upon the alleged merits of the design of the patent in suit it is deemed necessary to incorporate herein two of the four figures of the drawing of the patent, and a brief description thereof, in order to place the patent in its proper perspective and to show how really barren of any design patentable novelty, originality or design invention the patent actually is.

Moreover, this description of the design shown and claimed in the patent in suit is essential to an understanding of petitioner's erroneous argument as to the alleged commercial success of his fluorescent lighting fixtures, which do not embody the design of the patent as will be reviewed hereinafter.

As shown in the accompanying reproduction of Figs. 3 and 4 of the drawings thereof, the subject matter of the Spaulding design patent No. D-168,974, in suit, is a fluorescent lighting fixture.

March 3, 1953 J. H. SPAULDING Des. 168,974

FLUORESCENT LIGHTING FIXTURE

Filed Oct. 30, 1952 2 SHEETS—SHEET 2

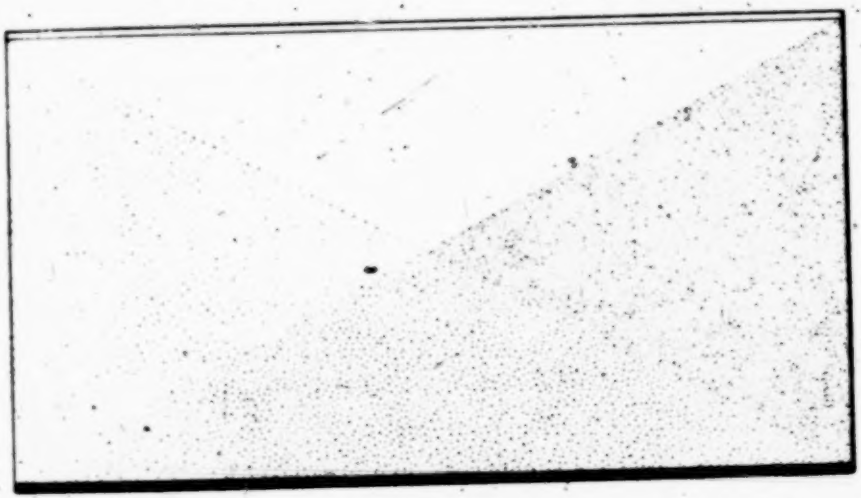

Fig. 3

Fig. 4

The design shown in the patent is of a plain and unornamented geometrical configuration and consists of an elongated housing having a pair of end walls, a top wall (to which further reference will be made presently), a flat longitudinally extending center bottom panel, and a pair of inclined side bottom panels which extend upwardly

from the center bottom panel at an angle of approximately 15° from the horizontal. The patent does not disclose any particular use to which the fluorescent lighting fixture disclosed therein is to be put and the patent is entirely silent in this regard.

As is best illustrated in the top plan view (Fig. 3) of the drawings of the Spaulding patent No. D-168,974, in suit, the fluorescent lighting fixture disclosed in the patent also includes a top wall which is pyramidal in shape and includes two triangular-shaped side panels (shown at the top and bottom in the accompanying reproduction of Fig. 3 of the drawings of the patent) and two triangular-shaped end panels (shown at the right and left). Each of the two triangular-shaped side panels has its apex at the center of the top wall of the housing and extends outwardly and downwardly to the ends of the side walls of the housing and, similarly, each of the two triangular-shaped end panels has its apex at the center of the top wall of the housing and extends downwardly and outwardly to the end walls of the housing.

The inclination or slope of the triangular-shaped side and end panels of the top wall of the housing in plaintiff's patent No. D-168,974 is further shown in the end view of the drawings (Fig. 4), reproduced above, and where each of the triangular-shaped side panels is shown as tapering upwardly from its lower edges to the apex thereof at the center of the top wall of the housing.

Except for this feature of the top wall panels, discussed above, and which the Court found to be "water drains" and, therefore, functional and utilitarian and not ornamental (Finding of Fact No. 21, Applt's. App. p. 10), the design of the patent in suit represents nothing but a conventional geometrical configuration (see the end view, Fig. 4) which is devoid of any design patentable novelty, originality or design invention.

That the decision of the Court of Appeals affirming the judgment of the District Court, finding the Spaulding patent No. D-168,974 invalid, was and is correct, will now be shown.

II.

The Decision of the Court of Appeals Affirming the Judgment of the District Court Finding the Spaulding Patent No. D-168,974 Invalid, Was and Is Correct.

The judgment of the District Court, finding the Spaulding design patent No. D-168,974 invalid, for the reasons set forth above, and as affirmed by the Court of Appeals, was based upon extensive Findings of Fact and Conclusions of Law (Applt's. App. pp. 5 to 17, inclusive).

As pointed out above, the only Conclusion of Law as to which the Court of Appeals expressed disagreement with the District Court, was Conclusion of Law No. 5 (Applt's. App. p. 17) in which the District Court held the Spaulding design patent No. D-168,974 invalid because of lack of patentable design novelty, originality and design invention over the prior art relied upon by the defendant, as identified in Conclusion of Law No. 5. However, the Court of Appeals affirmed the judgment of the District Court in all other respects, including Conclusions of Law Nos. 2, 3 and 4 (and the judgment as based thereon), reading as follows (Applt's. App. pp. 16, 17):

> "2. The Spaulding design Patent No. D-168,974 is invalid and void because of lack of design patentable novelty, originality and design invention;
>
> 3. The Spaulding patent No. D-168,974 is invalid and void because the design shown in the patent is functional and utilitarian and not ornamental;
>
> 4. The Spaulding patent No. D-168,974 is invalid and void because the design of the fluorescent lighting fixture shown therein represents merely the expected

skill of designers and mechanics working in the art of fluorescent lighting fixtures, and did not represent or require design invention."

As indicated above, it is believed that even a casual examination of Figs. 3 and 4 of the drawings of the Spaulding patent No. D-168,974 reveals that the design of the patent is devoid of any design patentable novelty, originality or design invention, apart from any consideration of the prior art relied upon by the respondent below (Conclusion of Law No. 2, Applt's. App. p. 16), and that it represents merely the expected skill of designers working in the art of fluorescent lighting fixtures and did not represent or require design invention (Conclusion of Law No. 4, Applt's. App. pp. 16, 17), as both the District Judge and the Court of Appeals found.

This leaves for consideration, therefore, only Conclusion of Law No. 3 (Applt's. App. p. 16), in which the District Court and the Court of Appeals found the patent in suit to be invalid and void because the design thereof is functional and utilitarian and not ornamental, and this will now be reviewed.

III.

The Decision of the Court of Appeals, Affirming the Judgment of the District Court, Finding the Spaulding Patent No. D-168,974 in Suit Invalid and Void Because the Design Shown Therein Is Functional and Utilitarian and Not Ornamental Was Correct and Was Based Upon Substantial Evidence.

The decision of the Court of Appeals, affirming the judgment of the District Court, finding the Spaulding patent No. D-168,974 invalid and void because the design shown therein is functional and utilitarian and not ornamental, was correct and was based upon substantial evidence, which will now be reviewed.

Thus, the District Court found in this regard as follows (Conclusion of Law No. 3, Applt's. App. p. 16):

> "3. The Spaulding patent No. D-168,974 is invalid and void because the design shown in the patent is functional and utilitarian and not ornamental."

Throughout the petition petitioner attempts to make it appear that the decision of the Court of Appeals, affirming the judgment of the District Court, finding the Spaulding patent No. D-168,974 invalid and void because the design shown therein is functional and utilitarian, and not ornamental, was not based upon any substantial evidence and was contrary to the evidence. The same contention was stressed by the petitioner before the Court of Appeals and was rejected since the evidence clearly reveals that the District Court's judgment of invalidity, based upon the finding that the design of the patent in suit is functional and utilitarian, and not ornamental, was based largely on the advertising material published by the petitioner himself and upon the testimony of certain of his witnesses. This evidence is reviewed in the District Court's Findings of Fact Nos. 16 to 21, inclusive (Applt's. App. 7-10), which read as follows:

> "16. Plaintiff's commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1, and defendant's accused fluorescent lighting fixture, as exemplified by DX 3, and DX 2, are used commercially for the illumination of pump islands and adjacent areas of gasoline filling stations and in use are mounted on supporting posts which extend above the pump island areas. The average height at which such fixtures are mounted, above ground level, is about 9 feet (R. 424) but under some conditions the height may be greater and may be as much as 12 or 14 feet. The mounting of defendant's accused fixture (PX 12) at a height of 14 feet, at the trial, was not in accordance with the defendant's usual practice since this fixture was made on special order for one of defendant's customers;

17. Plaintiff's magazine advertising, as exemplified by plaintiff's advertisement in National Petroleum News, issue of November 19, 1952, page 27 (PX 14) and plaintiff's advertisement in the April 1956 issue of National Petroleum News, page 72 (DX 9), uses the following expression in reference to plaintiff's commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1:

> 'Patented 15° angle (Pat. No. 168,942) throws MORE light over a WIDER area';

This and similar statements used by the plaintiff in connection with the advertising and sale of its commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1, are designed to create the impression, with the public, and in the trade, that the plaintiff's patent No. D-168,974 covers the 15° angle arrangement of the upwardly and outwardly extending (glass) side bottom panels of these fixtures, although the Spaulding patent No. D-168,974, in suit, does not extend to or cover this feature, *per se*, and plaintiff admitted at the trial (R. 365-6) that he does not have a patent on the 15° angle arrangement of the glass side bottom panels of his fluorescent lighting fixtures;

It is agreed between the parties that the reference in the above quotation to Pat. No. '168,924' is in error and that the reference should have been the Pat. No. D-168,974, in suit;

18. At page 27 of National Petroleum News, issue of November 19, 1952 (PX 14) the following additional statement is made by plaintiff in reference to plaintiff's commercial fluorescent lighting fixtures offered for sale under patent No. D-168,974, in suit, as testified to by plaintiff at the trial (R. 366):

> 'A. (Reading) "Instead of throwing all the light straight down on the island, Whiteway's unique 'Angle' construction distributes the light over the entire work area—even eliminating the need for flashlight for under-hood service. Their brilliant, yet pleasing, light forms a display that draws motorists into your modern, inviting estab-

fishment. When you re-light for more profits, get all you pay for with Whiteway 'Angle-Lume'."'

19. In his catalogue, (DX 4) the plaintiff used the following expressions in reference to his commercial fluorescent lighting fixtures which he advertises for sale under patent No. D-168,974, in suit:

'In "Angle Lume", science and Whiteway engineers have perfected the ultimate in island lighting. "Angle Lume", as the name implies, evenly distributes white, glareless light into every corner of your work area with minimum light loss.'

'The Whiteway "Angle Lume" Model AL makes all other island lighting systems obsolete by comparison. That's because you enjoy wide-angle side lighting . . . bountiful light to flood your entire work area in soft, pleasing light, not just your pump islands!'

'YOU GET—WIDER ANGLE LIGHTING!

Features 15° angle underside—28" full width—to give wider distribution of light. Light is thrown out and down—not down only! You get 84 sq. inches more glass emanation surface than any other light of similar design! There is less light trapped inside—more light outside!'

20. The testimony of plaintiff's witnesses, Seaton and Coffield, and the testimony of defendant's witness Akely, establishes that the primary purpose of the 15° angle arrangement of the (glass) side bottom panels shown in plaintiff's patent No. D-168,974, and in plaintiff's commercial fluorescent lighting fixtures, as exemplified by DX 11 and DX 1, and in defendant's accused fluorescent lighting fixtures, as exemplified by DX 3 and DX 2, is to spread the light from the illuminated (glass) side bottom panels during nighttime illumination of gasoline filling station pump islands, and adjacent areas, over a wider area than would be possible if the side bottom glass panels were flat, that is, horizontal. The evidence further establishes that

whatever ornamental appearance may be imparted to the design shown in the patent in suit, and to plaintiff's and defendant's commercial fluorescent lighting fixtures, by the 15° angle arrangement of the side bottom panels, is secondary and merely incidental to the primary utilitarian purpose of these upwardly and outwardly inclined (glass) bottom panels;

21. Plaintiff testified (R. 352-7-8) that the four triangular-shaped panels of the top wall of the fixture shown in the patent, and as embodied in PX 10, are 'water drains' which are designed to shed the water from the top wall of the fixture, and hence the design of the top wall of the patent in suit is admittedly primarily functional and utilitarian and not ornamental."

It will thus be seen that the District Court's Conclusion of Law No. 3 (Applt's. App. p. 16) that the design patent in suit is invalid because functional and utilitarian, and not ornamental, was based upon extensive and adequate evidence and findings of fact based thereon.

Being thus confronted with the evidence supporting the District Court's conclusion that the design patent in suit is invalid because function and utilitarian, and not ornamental, the petitioner attempts to make light of such evidence and the findings based thereon by *erroneously* contending that they are bottomed upon only a single advertisement of petitioner at a relatively late date. Thus, at page 10 of the petition petitioner makes the following erroneous statement:

> "The foregoing legal conclusion of invalidity predicated upon a single advertisement which appeared over four years AFTER the successful introduction of the Spaulding angle light reveals but another VERY OBVIOUS and EXCEPTIONAL SHOWING OF ERROR of which this Court should take cognizance."

The same erroneous contention, now advanced by the petitioner in this court, was also urged by the petitioner be-

fore the Court of Appeals in both his Main Brief and on Petition for Rehearing, and was rejected.

In making this contention petitioner attempts to make it appear that the advertisement referred to in the decision of the Court of Appeals, and which was published in the April, 1956 issue of National Petroleum News, page 72, appeared for the first time in that issue of that publication. However, the truth of the matter is, as shown by the District Court's Findings of Fact Nos. 17, 18 and 19 (Applt's App. pp. 8, 9) that exactly the same expression had been used by the petitioner three and a half years previously, and at least as early as November 19, 1952, in National Petroleum News, as shown by the District Court's Finding of Fact No. 17 (Applt's, App. p. 8) which reads, in part, as follows:

> "17. Plaintiff's magazine advertising, as exemplified by plaintiff's advertisement in National Petroleum News, issue of November 19, 1952, page 27 (PX 14), and plaintiff's advertisement in the April, 1956 issue of National Petroleum News, page 72 (DX 9), uses the following expression in reference to plaintiff's commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1:
>
> "'Patented 15° angle (Pat. No. 168,942) throws MORE light over a WIDER area';"

It will thus be seen that the decision of the Court of Appeals, affirming the judgment of the District Court, finding the Spaulding design patent No. D-168,974 in suit invalid because functional and utilitarian, rather than ornamental, was based upon substantial evidence which the Court of Appeals found not to be erroneous within the meaning of Rule 52(a) of the Federal Rules of Civil Procedure (*Graver Tank & Manufacturing Co. Inc.* v. *Linde Air Products Co.*, 336 U. S. 271, 275).

It is submitted, therefore, that the petitioner has shown

no basis for the granting of the petition herein or for a review by this Court based upon any alleged error of the Court of Appeals.

IV.

Petitioner's Contention That the Spaulding Design Patent No. D-168,974, in Suit, Should Be Held Valid Because of Alleged Commercial Success Is Without Merit and Forms No Basis for the Granting of the Writ Since This Contention Was Fully Reviewed and Rejected by Both the District Court and the Court of Appeals.

Petitioner's contention that the Spaulding patent No. D-168,974, in suit, should be held valid because of alleged commercial success is without merit and forms no basis for the granting of the writ since the same contention was fully and exhaustively reviewed and rejected by both the District Court and the Court of Appeals.

Thus, in both the District Court and in the Court of Appeals, the petitioner labored the contention that the Spaulding patent No. D-168,974, in suit, should be held to be valid because the design thereof is claimed to have been a commercial success. However, the District Court and the Court of Appeals both rejected this argument for the reason that any alleged commercial success claimed to have been enjoyed by the plaintiff's commercial fluorescent lighting fixtures was not shown to have been due to anything disclosed or claimed in the Spaulding patent No. D-168,974, in suit. That the judgment of the District Court and the decision of the Court of Appeals, affirming that judgment, in this respect, were and are correct will now be shown.

Thus, at the trial the petitioner and his witnesses endeavored strenuously to establish design patentable novelty, originality and invention in the plaintiff's design patent No. D-168,974, in suit, by attempting to show commercial

success and acceptance of plaintiff's commercial fluorescent lighting fixtures in the trade, and this contention is repeated in the Petition for the Writ of Certiorari in this Court (pages 3, 4, 5, 9, 11).

In fact, the principal point relied upon by the petitioner before the Court of Appeals, and in support of the Petition for the Writ of Certiorari in this Court, is that his commercial fluorescent lighting fixtures were commercially successful, and that this is an indication of design invention in the patent in suit. That this contention is in error will now be shown.

Thus, the District Court found that petitioner's evidence as to alleged commercial success was without significance since it had not been shown to have been due to anything disclosed in the patent in suit, the Court's findings in this regard being as follows:

> "14. *Plaintiff's current commercial fluorescent lighting fixtures, which plaintiff has manufactured and sold since sometime in the early part of the year 1955,* are exemplified by PX 11 and DX 1, and *do not come under and are not covered by the Spaulding patent No. D-168,974, in suit, because they do not embody the top wall design shown in Figs. 3 and 4 of the drawings of patent No. D-168,974,* but instead embody a top wall which has a longitudinally extending flat center portion and two downwardly extending generally rectangular-shaped top side panels which extend downwardly from the longitudinally extending top center panel to the side edges of the top wall of the housing and extend the full length of the housing. The housing in each of plaintiff's present commercial fixtures, as exemplified by PX 11 and DX 1, also includes end panels and a longitudinally extending center bottom panel, and two side bottom panels which extend upwardly and outwardly from the center bottom at an angle of about 15° from the horizontal;
>
> 30. At the trial the plaintiff introduced the testimony of witnesses designed to show commercial ac-

ceptance and success of plaintiff's present commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1, *but plaintiff offered no evidence to show that any part of whatever commercial acceptance or success his current commercial fluorescent lighting fixtures, as exemplified by PX 11 and DX 1, have had has been due to the design disclosed in his patent No. D-168,974, in suit, as distinguished from the utility of the plaintiff's commercial fluorescent lighting fixtures for the nighttime illumination of gasoline filling stations*, or to plaintiff's advertising of his commercial fluorescent lighting fixtures, the sales efforts of his sales representatives, and other factors, which have contributed to whatever commercial success and acceptance plaintiff's commercial fluorescent light[illegible] fixtures have had.

31. *Plaintiff's evidence as to commercial acceptance and success of his current commercial fluorescent lighting fixtures*, as exemplified by PX 11 and DX 1, *does not establish that the only specimen of plaintiff's commercial fluorescent lighting fixtures which embodies the design shown in his patent No. D-168,974, in suit, namely, PX 10, was ever commercially successful*, and plaintiff's evidence shows that the plaintiff abandoned the manufacture and sale of this fixture (PX 10), at least as early as the early part of the year 1955, for reasons of economy in manufacture (R. 388-9)."

That the District Court was correct in its Findings of Fact, Nos. 14, 30 and 31, quoted above, is clearly shown by the evidence, which will here be reviewed briefly in view of the reliance placed by petitioner on the argument as to commercial success (Petitioner's Brief, pp. 3, 4, 5, 9, 11).

The evidence in the matter of alleged commercial success was as follows:

(1) Petitioner offered no direct evidence to show that the only fluorescent lighting fixture which embodies the design of the patent, including a top wall having the four triangular-shaped panels shown in Figs. 3 and 4 of the

patent (PX 10), *had ever been commercially accepted by the trade or what part of his total sales, if any, had been of a fluorescent lighting fixture embodying the exact design of the patent*, as exemplified by PX 10, as distinguished from petitioner's other commercial fluorescent lighting fixtures (PX 11 and DX 1) which are not covered by the patent.

(2) The petitioner's sales manager, Switzer, testified that he had never sold the patented design, exemplified by PX 10, during the time he has been with the plaintiff company, namely, since sometime in the year 1955 (Applt's. App. p. 6, 7); and

(3) *That petitioner failed, completely, to establish that whatever commercial acceptance or success his commercial fluorescent lighting fixtures have had, if any has been due to the features shown in the patent on which the patent was granted including the housing embodying a top wall having the four triangular-shaped panels shown in Figs. 3 and 4 of the drawings of the patent.* Hence, the petitioner's attempt to establish design novelty and invention in the design patent in suit by alleged evidence of commercial success is entirely without legal significance *since such evidence of alleged commercial success, to be of any legal significance, must be shown to have been due to the features shown in the patent and for which the patent was granted.* That this is so is well established (*Standard Match Corporation v. Bell Mach. Co.*, 83 F. (2d) 365, 367 (CA 7), (1936)).

(4) *Petitioner's witness* and jobber, *Seaton, testified* on direct examination (Applt's. App. p. 5) *that the top wall design of the so-called Spaulding "angle light" has never been a factor as far as the sales appeal of the fixture is concerned.* This witness had seen only one fixture embodying the design of the top wall of the patent in suit and the one in court was the second one he had ever seen (Applt's. App. p. 4). This was confirmed by petitioner's witness,

Oswald, who testified (Applt's. App. p. 1) that it is the bottom wall arrangement, and not the top wall arrangement, that has contributed whatever success plaintiff has had with his commercial lighting fixtures and that the top wall is "entirely immaterial". In fact, petitioner's witness, Huber, testified (Applt's. App. p. 3) that he could not recall ever having sold one of petitioner's fixtures having the top wall design of the patent in suit.

The difficulty with all of the testimony offered by petitioner in attempting to establish commercial success was that it represented an attempt to attribute the alleged commercial success of petitioner's commercial lighting fixtures (as exemplified by PX 10 and DX 1) to a feature, namely, the upwardly inclined side bottom wall panels which are not covered, per se, by the patent in suit and on which the petitioner himself testified that he has no monopoly (on the 15° angle feature of the bottom panels) (Applt's. App. p. 19).

Moreover, while petitioner now endeavors to make it appear that the trade clamored for his commercial fluorescent lighting fixtures, after they were brought onto the market, his own sales manager, Switzer, testified that these fixtures required considerable sales effort. Thus he testified (Applee's. App. p. 8):

> "I would say that it just takes a job of selling, like you would a broom and mop."

It is perfectly clear, therefore, that whatever commercial acceptance and success petitioner's commercial fluorescent lighting fixtures have had has been due to factors other than the design shown in the patent.

It is submitted, therefore, that the Petition for the Writ of Certiorari herein, being based largely upon the refusal of the District Court and Court of Appeals to find the Spaulding patent No. D-168,974 in suit valid because of

alleged commercial success, was properly rejected by the District Court and the Court of Appeals and constitutes no basis for the grant of the petition for the Writ in this Court.

V.

Petitioner's Contention That the Respondent's Burden of Establishing Invalidity of the Patent in Suit Has Not Been Met Is Without Merit.

On page 2 of the Petition herein, under the heading "STATUTES INVOLVED", the petitioner attempts to make it appear that the respondent has not carried the burden of establishing invalidity of the Spaulding patent No. D-168,974 in suit.

However, this contention is totally without merit since it is based upon the erroneous contention that merely because the Court of Appeals disagreed with the District Court in regard to the District Court's Conclusion of Law No. 5 finding the patent in suit invalid because of lack of design patentable novelty, originality, and design invention over the prior art, that this, *somehow*, (in a manner not made clear by the petitioner) revitalizes the patent with the presumption of validity which attached to the patent when it issued from the Patent Office. This contention is made by petitioner notwithstanding the fact that the Court of Appeals affirmed the District Court in all of the other Conclusions of Law upon which the judgment of invalidity was based (Conclusions of Law Nos. 2, 3 and 4, Applt's. App. pp. 16, 17).

It is submitted, therefore, that the petitioner's contention that the respondent has not met the burden of establishing invalidity of the patent in suit is without merit and affords no basis for granting the petition herein sought.

VI.

Petitioner's Argument as to Application of Rule 52(a) of the Federal Rules of Civil Procedure Is Without Merit and Should Be Disregarded.

On Pages 2, 3, 6 and 7 of its petition herein, the petitioner makes the contention that this Court should grant the Writ herein sought upon the ground that the Findings of Fact of the District Court, as affirmed by the Court of Appeals, contain alleged error.

However, the petitioner's argument in this respect merely begs the question since nowhere does the petitioner point out wherein there is any error on the part of the District Court in its Findings of Fact upon which the judgment of invalidity of the patent in suit was based, as discussed above.

In support of this erroneous contention the petitioner cites and reviews, at pages 6 and 7 of the Petition, a number of cases, including *United States* v. *U. S. Gypsum Co., et al.*, 333 U. S. 364, 394, and *Graver Tank & Mfg. Co., Inc., et al.* v. *Linde Air Products Co.*, 336 U. S. 271, 275, involving the application of Rule 52(a) of the Rules of Federal Procedure, as revised. However these cases have no application whatever, to the facts in the present case since petitioner has failed to show any error in the District Court's Findings of Fact as affirmed by the Court of Appeals, as pointed out above.

VII.

Petitioner's Contention That the District Court and the Court of Appeals Failed to Apply the Correct Criterion of Invention as Applied to a Design Patent Is Devoid of Merit.

Under the heading "REASON FOR GRANTING THE WRIT", at page 5 of the Petition, the petitioner states that:

> "This case presents an important question as to whether the Lower Courts applied the correct criterion of invention as it applies to a design patent, and whether the record provides a 'factual' basis to support the legal conclusions reached by the District and Appellate Courts."

The petitioner then goes on to discuss the case of *Gorham v. White*, 81 U. S. 511, 525, and contends that the District Court and the Court of Appeals failed to apply the proper criterion of invention as applied to a design patent under that decision.

However, all that this argument amounts to is that the petitioner, being dissatisfied with the decisions of the lower courts, is now asking this Court to substitute its judgment as to the validity of the patent in suit for that of the lower courts.

Moreover, another fallacy in this argument is that the petitioner failed to establish in the District Court and in the Court of Appeals that any alleged commercial success enjoyed by his commercial fluorescent lighting fixtures was due to the design shown in the Spaulding patent No. D-168,974, in suit, as distinguished from other factors which enter into the complicated pattern of commercial success including advertising, salesmanship, etc.

As pointed out above there are many factors which may have been involved in any alleged commercial success of

the petitioner's commercial fluorescent lighting fixtures, as distinguished from the design shown in the patent in suit, and which may have been responsible for any alleged commercial success of plaintiff's commercial fluorescent lighting fixtures as distinguished from the design shown in the patent in suit.

Hence petitioner's argument that the lower courts failed to apply the proper criterion of invention as applied to a design patent is without merit and affords no basis for granting the Writ herein sought.

VIII.

The Judgment of the District Court and That of the Court of Appeals Were Based Entirely Upon and Related Solely to the Particular Facts of the Action Below and Present No Unique or Important Question of Law, Nor Any Conflict of Decisions, Reviewable by This Court.

The judgment of the District Court and that of the Court of Appeals for the Seventh Circuit were based entirely upon and relate solely to the particular facts of the action below and present no unique or important question of law reviewable by this Court.

Moreover, the Spaulding patent No. D-168,974, in suit, has not been involved in any other litigation so that there is no conflict between the decision and judgment of the lower courts in the present action and the judgment of any other Court, which might afford a basis for the grant of the petition herein prayed for.

Under these circumstances, it has long been held that the petition for the Writ herein sought should be denied.

Thus in the case of *Caroline M. Forsyth* v. *City of Hammond, et al.*, 166 U. S. 506, 41 L. Ed. 1095, 1098, 1099, this Court, in reiterating a policy with respect to granting cer-

tiorari, even then long established, said, at pages 514, and 515:

> "• • • it is a power which will be sparingly exercised, and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more courts of appeal, or between courts of appeal and the courts of a state, or some matter affecting the interests of this nation in its internal or external relations, demands such exercise."

In the case of *Layne and Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 67 L. Ed. 712, this Court said at page 393:

> "• • • It is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

To the same effect is Rule 19 (b) of the Rules of the Supreme Court of the United States, as revised.

It will thus be seen that there is no basis in fact or in law for the granting of the Writ herein prayed for.

CONCLUSION.

It is respectfully submitted, therefore, that for the reasons set forth above, and in the light of the authorities cited, the Petition for the Writ of Certiorari herein sought is without merit and should be denied.

Respectfully submitted,

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Sept. 23, 1959.

APPENDIX.

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

No. 12474 September Term, 1958, April Session, 1959.

JOSEPH H. SPAULDING, dba WHITEWAY MANUFACTURING COMPANY, *Plaintiff-Appellant*, v. GUARDIAN LIGHT COMPANY, INC., *Defendant-Appellee*. } Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

April 28, 1959

Before DUFFY, *Chief Judge*, and SCHNACKENBERG and KNOCH, *Circuit Judges*.

DUFFY, *Chief Judge*. This is a suit for the alleged infringement of Design Patent No. D-168,974 granted to Joseph H. Spaulding on March 3, 1953, on a design for a "Fluorescent Lighting Fixture." The application was filed October 30, 1952. Defendant filed a counterclaim for a declaratory judgment of invalidity and non-infringement.

The patent in suit discloses a lighting nxture in the form of a housing for fluorescent lighting equipment. The patent contains four drawings. Fig. 1 shows the inclined sides, the bottom and one end of the fixture; Fig. 2 is a bottom plan view; Fig. 3 is a top plan view, and Fig. 4 is an end elevational view.

The District Court held that if the patent were valid, defendant infringed, but further held that the patent was invalid. The basis for such decision was that the patent in suit was invalid a) because of lack of patentable design novelty, originality and design invention; b) because the design shown in the patent is functional and utilitarian and not ornamental; c) because the design of the patent represents merely the expected skill of designers and mechanics working in the art; and d) because of lack of patentable design novelty over the prior art.

The parties to this suit are competitors in the business of manufacturing and selling lighting equipment for illuminating the pump islands and adjacent areas of gasoline service stations and the exteriors of service station buildings.

Plaintiff claims to have pioneered the so-called angle bottom light which he introduced under Ulrick Patent No. D-168,812. Plaintiff asserts that although this light was vigorously promoted and threw more and better light over a greater area than previous lighting fixtures, it was a commercial flop because of its appearance. During the latter part of 1951, plaintiff claims he worked upon the design of a new fixture which would have "eye appeal." Three sample light fixtures embodying the new design were made for market testing in December, 1951. One hundred fifty of the Spaulding Angle lights were put up for sale in February, 1952, and plaintiff's witnesses testified they were very well received by the trade. Additional lights with many features of the patented design were sold but defendant claims that such fixtures were not made in accordance with the teachings of the patent in suit.

The design shown in the patent is of a plain unornamented geometrical configuration and consists of an elongated housing having a pair of end walls, a top wall, a flat longitudinally extending bottom panel and a pair of

inclined side bottom panels which extend upwardly from the center bottom panel at an angle of approximately 15° from the horizontal. When these lighting fixtures are installed at filling stations in the usual manner, they rest on tall pipes or standards, usually nine feet above ground level.

The top wall design is shown in Figs. 3 and 4 of the drawings of the patent in suit. The top wall of the fixture is slightly pyramidal in shape. The top wall contains four triangular shaped panels each of which has its apex at the center of the top wall of the housing. Two of these panels extend from the center downwardly and outwardly to the ends of the side walls of the housing. The other two extend downwardly and outwardly to the ends of the end walls of the housing.

There is no description in the specifications or in the claim as to any dominant feature of the design. The claim of the patent in suit is commensurate with the drawings, and it incorporates by reference the design shown in the drawings and reads: "The ornamental design for a fluorescent lighting fixture, as shown." It has been held that where a patent did not point out any particular feature of novelty, every element of the design was essential. *Dixie-Vortex Co.* v. *Lily-Tulip Cup Corp.*, 2 Cir., 95 F. 2d 461.

Title 35 U. S. C. A. § 171 reads: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided." The present statute omits the term "useful" which was employed in earlier statutes.

A design patent, in order to be valid, must disclose a

design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman. *Hopkins* v. *Waco Products, Inc.*, 7 Cir., 205 F. 2d 221; *Hueter* v. *Compco Corp.*, 7 Cir., 179 F. 2d 416; *Capex Co.* v. *Swartz*, 7 Cir., 166 F. 2d 5. Originality imparts something of uniqueness and character,—something more than mere novelty. 69 CJS, Patents § 73 at page 350. A design patent cannot be obtained to protect a mechanical function or cover an article whose configuration affects its utility alone. 69 CJS, Patents § 73, page 351.

In the case at bar, plaintiff stresses the importance of commercial success. Plaintiff insists that the immediate commercial acceptance of the Spaulding fixture is impressive evidence of patentability. We have held, and it is the general rule, that in a close case commercial success may tip the scales in determining whether an improvement amounts to an invention. *Hueter* v. *Compco Corp.*, *supra*, page 418. However, in the *Hueter* case we pointed out that the Supreme Court in *Jungersen* v. *Ostby & Barton Company*, 335 U. S. 560, 567 said: "Where, as here, however, invention is plainly lacking, commercial success cannot fill the void."

In the case at bar the District Court found that plaintiff failed to show that whatever commercial success his commercial lighting fixture had attained was due to the design disclosed in the patent in suit as distinguished from the utility of the fixture, the sales efforts of plaintiff and other factors. The Court also found there was no sufficient showing that any light fixture manufactured by plaintiff embodying the design of the patent in suit, was commercially successful, as plaintiff had abandoned the manufacture and sale of this fixture as early as the early part of 1955, for the reason of economy in manufacture. We cannot say that this finding is clearly erroneous.

We do not agree with the District Court that the patent in suit is invalid because lacking patentable novelty, originality and design invention over the prior art. The Court mentioned nine prior art patents, seven of which were not cited by the Patent Office. We think the four prior art patents cited by the Patent Office Tribunals more closely approach the design of the Spaulding Angle Light than any one of the seven additional patents mentioned. To illustrate, Guth Patent No. 2,488,012 and Guth No. 2,401,635 are mechanical patents and are merely cumulative if not identical with Guth No. D-148,695 which was cited by the Patent Office.

The District Court found that plaintiff's design patent in suit was invalid because it is functional and utilitarian rather than ornamental. In *Hopkins* v. *Waco Products, Inc.*, 205 F. 2d 221, 223, we said: "A design dictated by mechanical or functional requirement is not patentable." And, in the *Hueter* case, *supra*, page 417: "The courts have many times held that a purely functional design or one dictated by mechanical or functional requirements is not patentable." In the case at bar, this question is a rather close one. However, the plaintiff did advertise in the April, 1956 issue of National Petroleum News, page 72, with reference to his commercial fluorescent lighting fixture "Patented 15° angle (Pat. No. 168,942)[1] throws MORE light over a WIDER area." This advertisement gave the impression that the fifteen degree angle arrangement of the glass side bottom panels was patented. Of course, plaintiff has or had no patent on that feature. We think the District Court's finding is not clearly erroneous and agree that the patent in suit is invalid because the design was functional and utilitarian rather than ornamental.

1. It was agreed by the parties that the number of the patent given in the advertisement was in error and that plaintiff intended to refer to No. D-168,974 in suit.

It would unduly extend this opinion to discuss in detail other points raised by the parties. We are content to state that the record before us supports the trial court's conclusion that the design of the fluorescent lighting fixture in suit represents merely the expected skill of designers and mechanics working in the art and did not represent design invention.

AFFIRMED.